

In re Patent Application of:
THOMSON ET AL.
Serial No. 09/658,389
Filed: September 8, 2000

the clamp is moved in a confined and tight clamp receiving passageway as shown in FIGS. 2 and 13". Applicants respectfully submit that the claims do not recite a "confined and tight clamp receiving passageway", nor does the specification. The canted position recited in the claims refers to the fastener receiving passageways, and, of course, there is provided clearance to permit the clamp portions to be positioned in the passageway as would be readily understood by those skilled in the art. The subject matter of the above referenced claims has been described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the claimed invention.

The arguments supporting patentability of the present invention are found below.

I. The Double Patenting Rejection Is Improper

The Examiner issued a non-statutory double patenting rejection of Claims 1-3, 10, 12, 13, 15, 17, and 20-22. More particularly, the Examiner notes that the claims are unpatentable over Claims 1-27 of co-pending Patent Application Serial No. 09/658,509 in view of the Lai patent. Applicants respectfully disagree with the Examiner and submit that the present application and the co-pending patent application are directed to completely different aspects of the bicycle stem. The claims of the present application are directed to a steering tube clamping portion of a bicycle stem. Claims 1-27 of the above-referenced co-pending application, however, are directed to a handlebar clamping portion. The handlebar clamping portion is located at the opposite end of the stem body from the steering tube clamping

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portion. It is used to clamp a completely different bicycle component than the steering tube clamping portion of the present application. Applicants therefore submit that the present claims are directed to different aspects of the bicycle stem and that there will exist no improper timewise extension of the right to exclude. Therefore the double patenting rejection is improper and should be withdrawn.

II. The Claimed Invention

The invention, as recited in independent Claim 1, for example, is directed to a bicycle stem for connecting a bicycle handlebar to a bicycle steering tube. The bicycle stem comprises a body portion having opposing first and second ends, a handlebar clamping portion connected to the first end of the body portion, and a steering tube clamping portion. The steering tube clamping portion is connected to the second end of the body portion and has a tubular shape defining a steering tube receiving passageway therethrough. The steering tube clamping portion also has a clamp receiving passageway therein transverse to and in communication with the steering tube receiving passageway.

The bicycle stem further comprises a steering tube clamp in the clamp receiving passageway. The steering tube clamp comprises a pair of cooperating clamp members aligned in side-by-side relation and comprising respective portions defining an imaginary cylinder and a recess therein for the steering tube. Each clamp member also has at least one fastener receiving passageway therein that is offset a predetermined distance from an axis defined by the imaginary cylinder. The steering tube clamp also comprises at least one fastener extending between

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corresponding fastener receiving passageways of the pair of clamp members for urging the clamp members together to engage the steering tube and thereby secure the bicycle stem to the steering tube.

Independent Claim 17 recites that the body portion, handlebar clamping portion, and steering tube clamping portion are integrally formed as a monolithic unit. Independent Claim 24 recites a plurality of fasteners extending between corresponding fastener receiving passageways of the pair of clamp members for urging the clamp members together to engage the steering tube and thereby secure the bicycle stem to the steering tube. Independent Claim 33 recites that the fastener receiving passageway is canted at a predetermined angle from parallel to an axis of the imaginary cylinder.

III. The Claims Are Patentable

The Examiner rejected independent Claim 1 over the Lai patent. The Examiner contends that the Lai patent teaches a bicycle stem having a steering tube clamp that includes a pair of clamp members having at least one fastener receiving passageway therein offset a predetermined distance from an axis defined by an imaginary cylinder defined by the clamp portions. Applicants submit, however, that the Examiner has mischaracterized the Lai patent. The Lai patent is merely the same prior art as shown in FIGS. 4 and 5 of Applicants' specification to highlight the shortcomings of this type of prior art clamp.

More specifically, as illustrated in FIG. 6 of the Lai patent, the fastener receiving passageway 86 passes directly along the axis of the imaginary cylinder defined by the clamp

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members. Applicants assert that the fastener receiving passageways of the Lai patent are not offset from the axis, and that independent Claim 1 is therefore patentable over the Lai patent.

The Examiner rejected independent Claim 17 over the Lai patent in view of the Roddy patent. The Examiner correctly recognized that the Lai patent fails to teach the body portion, the handlebar clamping portion, and the steering tube clamping portion being integrally formed as a monolithic unit. As discussed above, the fastener receiving passageways of the Lai patent are not offset from the axis. The Examiner contended that the Roddy patent shows a handlebar clamping portion and a steering tube clamping portion being integrally formed as a monolithic unit. Applicants submit, however, that the Examiner has also mischaracterized the Roddy patent. The Roddy patent does not teach or suggest the clamp receiving passageways and clamp portions therein for clamping to a steering tube. Applicants assert that combining the disjoint pieces of the Roddy and Lai patents still fails to produce the claimed invention.

The Examiner also rejected independent Claim 24 over the Lai patent in view of the Roddy patent. The Examiner correctly recognized that the Lai patent fails to disclose a plurality of fasteners. The Examiner contended that the Roddy patent discloses two bolts used to fasten the steering tube clamping portion to the handlebar clamping portion. As described above, however, a combination of the disjoint pieces of the Lai and Roddy patents still fails to produce the claimed invention, as described above.

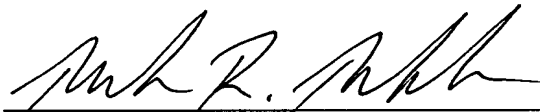
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It is respectfully submitted that independent Claims 1, 17, 24, and 33 are patentable for the reasons detailed above. In view of the patentability of the independent claims, it is also submitted that their dependent claims, which recite yet further distinguishing features, are also patentable. These dependent claims require no further discussion herein.

CONCLUSION

In view of the arguments provided above, it is submitted that all the claims are patentable. Accordingly, a Notice of Allowance is requested in due course. Should any minor informalities need to be addressed, the Examiner is encouraged to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: DIRECTOR, U.S. PATENT AND TRADEMARK OFFICE, WASHINGTON, D.C. 20231, on this 3rd day of June, 2002.

A handwritten signature in cursive script, appearing to read "Thomas L. Thomson", written over a horizontal line.

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